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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/873,714 | 06/04/2001 | Morenike Awokola | FA1002 US NA | 4978 |

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E I DU PONT DE NEMOURS AND COMPANY
LEGAL PATENT RECORDS CENTER
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4417 LANCASTER PIKE
WILMINGTON, DE 19805

EXAMINER

TSOY, ELENA

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

1762

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/873,714

Applicant(s)

AWOKOLA ET AL.

Examiner

Elena Tsoy

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Advisory Action

1. Request for Reconsideration filed on 3/31/2006 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance for the reasons of record set forth in the Final Office Action mailed on 1/05/2006.

Response to Arguments

2. Applicants' arguments filed 3/31/2006 have been fully considered but they are not persuasive.

Applicants state that even though the Examiner has repeatedly asserted that Maag et al. in view of Richard establishes a prima facie case of obviousness, such repetition does not change the fact that those disclosures do not teach or suggest a reactive diluent comprising at least one methacrylic acid ester being formed by reacting methacrylic acid with at least one cycloaliphatic alcohol. Contrary to the Examiner's assertions, the fillers in Maag et al. are not produced via reacting methacrylic acid with at least one cycloaliphatic alcohol (see Statement 4 of the Löffler declaration, submitted along with the response to the June 22, 2005, Non-Final Office Action). The Examiner either ignored or disregarded Statement 4 of the 132 declaration where Mr. Löffler concluded that the Examiner's assertion that Maag et al. disclose cycloaliphatic methacrylates is incorrect. Applicants see no evidence in the present office action, or in any other office action, demonstrating that Mr. Löffler's statement is false or is only an opinion (which it is not, as evidenced by Maag et al. itself at col. 2, line 62 - col. 3, line 9). Thus, the Examiner's bare assertion that the fillers in Maag et al. are produced via reacting (methacrylic acid with at least one cycloaliphatic alcohol, and in turn the Examiner's prima facie case, cannot stand. To illustrate, Maag et al. disclose that several (methacrylates such as polyurethane (methacrylates, epoxy

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(methlacrylates, (methlacrylic-functional (methlacrylic copolymers, etc. can be used as prepolymers (polymers or oligomers) (see col. 2, line 65 - col. 3, line 4). These prepolymers contain, as the term "prepolymers" implies, (methlacrylic ester groups as unsaturated groups. Further, these prepolymers have a molar mass of 200 to 10,000, and they contain 2 to 20 double bonds per molecule (whereas the reactive diluents of Applicants' claimed invention are definitely monounsaturated). The main criterion to distinguish between, e.g., oligomeric prepolymers (composed of 2 to about 5 monomer units) and monomeric reactive diluents is the capability of the latter to function as solvents (liquid monomers with an appropriate viscosity) for the prepolymers. Thus, the prepolymers of Maag et al. are not reactive diluents (liquid monomers) even if the lower limit of molar mass is quite low and could overlap with the molar mass of specific reactive diluents.

The Examiner respectfully disagrees with this argument. The Examiner didn't ignore or disregard Statement 4 of the 132 declaration where Mr. Löller concluded that the Examiner's assertion that Maag et al. disclose cycloaliphatic (methlacrylates is incorrect. The Examiner will explain her position more clearly: Maag et al teach that monosaturated reactive diluents are **methacrylic acid esters** (See column 3, lines 18-21). Since Maag et al do NOT limit their teaching to *particular* monosaturated methacrylic acid esters, they include monosaturated methacrylic acid esters of **any** alcohols including **cycloaliphatic** alcohols (i.e. ester formed by *reacting* methacrylic acid with the cycloaliphatic alcohol) such as those **cycloaliphatic** alcohols mentioned at column 3, lines 5-9 as long as methacrylic acid esters of cycloaliphatic alcohols are **liquid monosaturated monomers** especially considering the fact that Maag et al use the same type of compounds as binders and as reactive diluents. For example, *polyether methacrylates* are used

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as binders (See column 3, line 1) and *polyethylene glycol* dimethacrylate (*polyether* methacrylates) as reactive diluents (See column 3, lines 24-25).

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is 571-272-1429. The examiner can normally be reached on Monday-Thursday, 9:00AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy
Primary Examiner
Art Unit 1762

ELENA TSOY
PRIMARY EXAMINER
E/Tsoy

April 5, 2006